



**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Tsuyoshi KANEKO et al.

Group Art Unit: 2822

Application No.: 10/092,777

Examiner: M. Wilczewski

Filed: March 8, 2002

Docket No.: 112181

For: METHOD OF FABRICATING SURFACE-EMISSION TYPE LIGHT-EMITTING DEVICE, SURFACE-EMITTING SEMICONDUCTOR LASER, METHOD OF FABRICATING THE SAME, OPTICAL MODULE AND OPTICAL TRANSMISSION DEVICE

**RESPONSE TO ELECTION OF SPECIES REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the September 23, 2004 Election of Species Requirement, Applicants provisionally elect Species I, in which the second resin layer having a lower solubility than the first resin layer is formed in a specific liquid, with traverse. At least claims 1, 2, 6, 7 and 9-16 read on the elected species.

Moreover, it is respectfully submitted that the Office Action is on its face unreasonable because the Office Action 1) equates claims with species and 2) fails to show that the species are mutually exclusive.

Species are always different embodiments and claims are never species (see MPEP § 806.04(e)). However, in this case, the Office Action states that Species I is directed to claims 1, 2, 6, 7 and 9-16, Species II is directed to claims 3 and 8, Species III is directed to claims 4 and 5, and Species IV is directed to claims 28-31 and 33. Because the Office Action

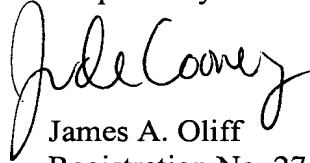
improperly equates claims with species, withdrawal of the Election of Species Requirement is respectfully requested.

Moreover, the Office Action asserts that because claims 1, 2, 6, 7 and 9-16 claim that the second resin layer is formed in a specific liquid and claims 3 and 8 claim the second resin layer is formed by semi-curing, these respective groups of claims are different species. However, the Office Action fails to satisfy its burden of showing that the claims are mutually exclusive. The Office Action must show that at least one claim recites limitations which are found in a first species but not in a second, while a second claim recites limitations for the second species and not the first (see MPEP § 806.04(f)). In this case, the Office Action fails to put forth any basis as to why forming a second resin layer in a specific liquid is mutually exclusive from forming a second resin layer by semi-curing. Likewise, with regard to species III and IV, the Office Action fails to put forth why these species are mutually exclusive from each other and the other species.

It is also respectfully submitted that the subject matter of all species is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,



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Date: **October 21, 2004**

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